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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,828

07/31/2006

Hiromasa Shoji

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,828	<b>Applicant(s)</b> SHOJI ET AL.	
	<b>Examiner</b> Michael La Villa	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080111</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
2. A person shall be entitled to a patent unless –
3. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 1, 2, 7, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al. WO 02/103080. Nakayama et al. teaches coating a metal sheet with a titanium oxide and/or titanium hydroxide layer which is further coated with organic layer. Nakayama et al. also exemplifies coating a metal sheet with a zirconium oxide and/or zirconium hydroxide layer which is further coated with in situ formed organic layer. See Nakayama et al. EP 1 405 933 (Abstract; paragraphs 8-15, 34, 39, 40, 48-68, 81, 86-89-94, and 98)(translation of Nakayama et al. WO 02/103080).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. USPA 2003/0072962 for the reasons of record in the Office Action mailed on 10 October 2007.
8. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al. WO 02/103080. Nakayama et al. teaches coating a metal sheet with a titanium oxide and/or titanium hydroxide layer which is further coated with organic layer. Nakayama et al. also exemplifies coating a metal sheet with a zirconium oxide and/or zirconium hydroxide layer which is further coated with in situ formed organic layer. See Nakayama et al. EP 1 405 933 (Abstract; paragraphs 8-15, 34, 39, 40, 48-68, 81, 86-89-94, and 98)(translation of Nakayama et al. WO 02/103080). With respect to Claim 3, while Nakayama et al. may not exemplify coating both surfaces of the sheet of Nakayama et al. with coat layer, it would have been obvious to one of ordinary skill in the art at the time of the invention to coat both surfaces in order to confer corrosion protection to both surfaces in circumstances in which both surfaces would be expected to be exposed to corrosive conditions. With respect to Claims 4-6, Nakayama et al.

teaches that large coating thicknesses for the coat layer on the order to 800 to 1000 mg/m<sup>2</sup> or higher provide effective corrosion resistance, although layer cracking is observed. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide coat layer thicknesses within the suggested range in order to confer corrosion protection. It would be expected that the resulting film would possess a cracked structure, which can also be characterized as possessing island structuring.

### ***Response to Amendment***

9. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 10 October 2007. Rejection is withdrawn.
10. In view of applicant's amendments and arguments, applicant traverses the section 103 rejection over Matsuzaki of the Office Action mailed on 10 October 2007. Applicant argues that the claimed coat layer is metal oxide and/or metal hydroxide alone, in contrast to Matsuzaki's layer which may contain other ingredients. Applicant's coat layer is characterized with "consisting essentially of" language, which does not preclude other ingredients. Applicant bears the burden of demonstrating that the other ingredients of the prior art should be precluded by the "consisting essentially of" language. See MPEP 2111.03. It is unclear where applicant has provided this evidence and/or argument. Applicant's comment that applicant aims to provide an adherent coating, whereas Matsuzaki is only

concerned with corrosion resistance does not appear to constitute a meaningful distinction since Matsuzaki's corrosion resistance optimization could not be achieved absent favorable adherence. Rejection is maintained.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael La Villa/  
Michael La Villa  
Primary Examiner, Art Unit 1794  
23 May 2008